

## **REMARKS / ARGUMENTS**

In response to the pending Office Action of June 23, 2009, Applicants present the following arguments. Applicants submit that in light of this response, this application is in condition for allowance. Accordingly, reconsideration of all pending rejections and objections, and passage to allowance is respectfully requested. Claims 1-8 remain pending herein.

### **1. Rejection of claims 1 – 8 under 35 U.S.C. § 103(a)**

The Examiner has rejected claims 1-8 under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2006/0154020 to Kasuya et al. [hereinafter, “the '020 application”]. Applicants submit, however, that the '020 application does not qualify as prior art under 35 U.S.C. §§ 102(a), (b) or (e)(1), and therefore cannot support an obviousness rejection under 35 U.S.C. § 103(a).

The effective filing date of the instant application is the filing date of the PCT international application designating the United States. [See, M.P.E.P § 1893.03(b): “It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application”]. The international stage application of the instant application was filed on **March 29, 2005**, and therefore is the effective U.S. filing date.

The '020 application publication does not qualify as prior art under § 102(a) because the publication date of this reference is after the March 29, 2005 effective filing date of the instant application. The '020 application was published July 13, 2006, well after the March 29, 2005 effective U.S. filing date of the instant application. The '020 application is, therefore, not available as prior art under § 102(a). [See, 35 U.S.C. § 102(a) and M.P.E.P. § 706.02(a): “For 35 U.S.C. 102(a) to apply, the reference must

have a publication date earlier in time than the effective filing date of the application, and must not be applicant's own work"].

The '020 application publication does not qualify as prior art under § 102(b) because it was published less than one year before the effective filing date of the instant application. Under § 102(b), a publication may serve as prior art if it was published more than one year before the effective filing date of the application. [See, 35 U.S.C. § 102(b) and M.P.E.P. § 706.02(a)]. Here, the '020 application was published July 13, 2006, well after the March 29, 2005 effective U.S. filing date of the instant application. Because the '020 application was not published more than one year before the effective filing date of the instant application, it does not qualify as prior art under § 102(b).

The '020 application publication does not qualify as prior art under § 102(e)(1) because the international application of the '020 application designating the U.S. was not published in English under PCT Article 21(2) and because it entered the U.S. national stage after the effective U.S. filing date of the instant application. There are three requirements for a U.S. application to be afforded its international filing date for prior art purposes under § 102(e)(1): (i) the international application was filed on or after November 29, 2000; (ii) the international application designated the United States; and (iii) the international application was **published in English**. [See, 35 U.S.C. § 102(e) and M.P.E.P. § 706.02(f)(1)]. Regarding the '020 application, Applicants note that PCT international application no. PCT/JP04/04165 was published on April 14, 2005 in Japanese. The '020 application, therefore is not afforded its international filing date for prior art purposes under § 102(e)(1). [See, M.P.E.P. § 706.02(f)(1): "If the international application...was not published in English under PCT Article 21(2), do not treat the international filing date as a U.S. filing date for prior art purposes" (emphasis in original)]. Rather, the effective date for prior art purposes under § 102(e)(1) is the U.S. national stage filing date of July 8, 2005. [See, M.P.E.P. § 706.02(f)(1)]. Since the effective § 102(e)(1) date of the '020 application is well after the March 29, 2005

effective filing date of the instant application, this reference is not available as prior art under § 102(e)(1).

Because the '020 application publication does not qualify as prior art under 35 U.S.C. § 102, it cannot be used to support an obviousness rejection under 35 U.S.C. § 103(a). The '020 application is the only reference on which the Examiner has relied in rejecting claims 1-8. Furthermore, the Examiner has made no other rejections of claims 1-8 independent of the '020 application. Therefore, withdrawal of the rejection, reconsideration, and passage to issuance is respectfully requested.

### **CONCLUSION**

In view of the foregoing arguments, this case is considered to be in condition for allowance and passage to issuance is respectfully requested. If new issues of patentability are raised, the Examiner is invited to call and arrange for an opportunity to discuss these issues via phone interview.

It is not believed that an extension of time is required with this submission. If this is incorrect or if problems are encountered using the EFS-Web system, please deduct or credit the appropriate fees for this submission along with any extension of time required from Deposit Account No. 07-1969.

Respectfully submitted,

/sbbaroneREG53968/

Stephen B. Barone  
Reg. No. 53,968  
Customer No. 23713

**GREENLEE, WINNER AND SULLIVAN, P.C.**  
4875 Pearl East Circle, Suite 200  
Boulder, CO 80301  
Telephone: (303) 499-8080  
Facsimile: (303) 499-8089  
E-mail: [usptomail@greenwin.com](mailto:usptomail@greenwin.com)  
Attorney Docket No. 100-06  
September 15, 2009